UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,769	09/14/2006	Werner Reinhart	1093-146 PCT/US	9833

23869 7590 03/17/2011
HOFFMANN & BARON, LLP
6900 JERICHO TURNPIKE
SYOSSET, NY 11791

EXAMINER	
JOY, DAVID J	

ART UNIT	PAPER NUMBER
1785	

MAIL DATE	DELIVERY MODE
03/17/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/561,769	REINHART ET AL.	
	Examiner	Art Unit	
	David J. Joy	1785	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 December 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4 and 6-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-10 and 12-28* is/are rejected.

7)☒ Claim(s) *11* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 December 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *03/08/2011*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-4 and 6-28 are pending as amended on November 24, 2010 and December 22, 2010, with Claim 5 having been previously cancelled.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendment

3. Applicant's discussion of the rejection of Claim 11, filed November 24, 2010, obviates the previously cited rejection under 35 U.S.C. §103. As such, the rejection of Claim 11 under 35 U.S.C. §103(a), as being unpatentable over the U.S. Patent of Burchard et al. (6,030,691; hereinafter "Burchard") in view of the U.S. Patent Application Publication of Holmes et al. (2003/0058491; hereinafter "Holmes"), has been withdrawn.

Claim Rejections - 35 USC § 102

4. Claims 1-4, 6-10 and 12-28 stand rejected under 35 U.S.C. 102(b) as being anticipated by Burchard.

5. Burchard teaches a strip for safeguarding a document ("antifalsification paper having a security element in the form of a thread of band") having a longitudinal direction and two opposing surfaces, and in the longitudinal direction an alternation of metallic regions and transparent regions, such that the regions extend between the opposing surfaces of the strip (see Abstract; see also Figures 1-3; see also Column 2, Lines 43-65; see also Column 4, Lines 30-50). Burchard also teaches that the alternating metallic and transparent regions produce a macro-contrast on the document that makes forgeries difficult and prevents the document from being imitated with a copying machine (see Column 2, Lines 43-65). In addition, Burchard teaches that strip includes optically active elements associated with the metallic and transparent regions that produce an optical effect on a less than macro-contrast scale (i.e., micro-contrast) that makes it possible to identify the document (see Column 3, Lines 23-60). Specifically, Burchard provides that the strip includes large, easy-to-read writing (with "large" defined as being 1 mm high) and small writing visually difficult to resolve (with "small" defined as being smaller values) (*Id.*).

6. Burchard teaches that the strip produces an optical effect that is dependent on the angles of illumination and/or observation of the strip, and that the strip also

produces a contrasting color shift (or multicolor shift) (see Column 3, Line 61 – Column 4, Line 12). Burchard also teaches that the transparent regions of the strip can be coated with a varnish that produces a glossy effect visible to the naked eye, given that Burchard recites that the transparent substrate can be coated with dyes that include luminescent inks that improve the visual impression of the thread material even further and make it more effective (*Id.*). Further, Burchard teaches that the optically active elements are metallized optically active structures, and that the structures can comprise such elements as purely reflective metallized zones, diffraction lines, holographic zones, demetallized zones of a metallized area, a zone bearing printing, and a metallized zone of a transparent region (see Figures 2 and 3; see also Column 2, Lines 43-65; see also Column 4, Lines 40-59; see also Column 5, Lines 1-24; see also Column 6, Lines 26-44). Additionally, Burchard teaches that the optically active structures comprise different zones of the elements, that some of the zones are not perceptible to the naked eye, that the optically active elements are associated with purely metallic regions, and that the purely metallic regions are disposed on respective sides of the metallized regions of the strip (see Figures 2, 3, 5 and 9; see also Column 4, Lines 40-59; see also Column 5, Lines 1-13; see also Column 5, Line 59 – Column 6, Line 2; see also Column 6, Lines 15-26). Burchard also teaches that the purely metallic regions are disposed such that a transparent interval is located between the purely reflective region and the metallized

region (see Figures 10 and 11; see also Column 6, Lines 3-14). In addition, Burchard teaches that the optically active elements can be associated with transparent regions, that the metallized regions can be disposed adjacently to the transparent regions, and that there can be an interval between the metallized regions and the transparent regions (see Figures 2-5, 7, 9 and 10; see also Column 4, Lines 40-59; see also Column 5, Lines 1-13; see also Column 5, Lines 25-35; see also Column 5, Line 59 – Column 6, Line 5; see also Column 6, Lines 15-26). Burchard also teaches that the intervals can be metallized and diffractive zones, printed zones, or a hologram (*Id.*). Burchard also provides that the optically active elements are in register relationship with the metallized and/or transparent regions of the strip (see Figures 2-4; see also Column 4, Lines 40-67). Additionally, Burchard provides that the regions and the optically active elements can be luminescent motifs ("luminescent characters or patterns"), and that the luminescent motifs can be printed so as to overlap the metallic regions or the strip, overlap the transparent portions of the strip, or be incorporated into the strip (see Figures 2-7; see also Column 3, Line 62 – Column 4, Line 12; see also Column 4, Line 40 – Column 5, Line 35). Further, Burchard recites that the strip can be incorporated into such security documents as bank notes, checks, shares, traveler's checks, check and credit cards, passports, identity cards (see Figure 1; see also Column 1, Lines 19-32; see also Column 4, Lines 30-39).

Potentially Allowable Subject Matter

7. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: A search of the prior art did not generate a reference that teaches or fairly suggests a document safeguard strip wherein the optically active elements comprise a diffraction mat that is integrated into a diffractive metallized region of the strip. As is asserted by Applicant, in the amendment filed November 24, 2010, Holmes teaches an optically variable security device that incorporates one diffractive structure and a second optically variable effect using a thin film reflection filter device. However, the thin film reflection filter device that is taught is not a diffractive structure.

Response to Arguments

9. Applicant's arguments filed November 24, 2010 and December 22, 2010 have been fully considered. While the argument directed to the rejection of Claim 11 as being unpatentable over Burchard in view of Holmes was persuasive (as discussed *supra*), the remaining argument is not persuasive.

10. Applicant argues that Burchard does not disclose three-dimensional structures for the optically active structures taught therein, and that the optically active structures that are claimed in amended Claim 1 are all well known three-dimensional structures. However, Examiner respectfully disagrees with Applicant's assertion. While it would appear from the explanations provided by Burchard that the optically active structures manage to create a three-dimensional appearance to the naked eye, it should also be clear that in any instance where structures are applied to the surface of a substrate (i.e., by printing, or by overlaying multiple layers), the resulting structure will inherently be three-dimensional, even though the magnitude of the third dimension (i.e., the height or the thickness involved) may be so minute that it is almost unnoticeable. Likewise, there is nothing in the instant claims that establishes the optically variable structures as being distinctively three-dimensional, and there is also no recitation in the disclosure that supports the assertion of the structures' three-dimensional orientation (e.g., in the drawings, and/or the specification). Therefore, there is no substantive basis for Applicant's assertion that the claimed structures are patently different from what is taught in the reference.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

12. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Joy whose telephone number is (571) 272-9056. The examiner can normally be reached on Monday - Thursday, 7:00 AM - 5:30 PM EST.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Ruthkosky can be reached on (571) 272-1291. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Ruthkosky/
Supervisory Patent Examiner, Art Unit 1785

/DJJ/
Examiner, Art Unit 1785